

REMARKS

Claims 1-24 were pending in the Application. Applicant cancelled claim 7 without prejudice or disclaimer. Hence, claims 1-6 and 8-24 are pending.

Claims 1-24 remain objected for informalities. Claims 7-14 and 22 remain rejected under 35 U.S.C. §112, first paragraph. Further, claims 7-14, 22 and 24 remain rejected under 35 U.S.C. §112, second paragraph. Additionally, claims 1-6, 15, 18-20, 23 and 24 remain rejected under 35 U.S.C. §102(b) as being anticipated by Bernstein et al. (U.S. Patent No. 3,055,117) (hereinafter "Bernstein"). Further, claims 7-14 and 22 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of Griffin et al. (U.S. Patent No. 5,154,448) (hereinafter "Griffin"). Additionally, claims 16 and 17 remain rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of Raymond (WO 99/56270). Furthermore, claim 21 remains rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein in view of Itakura et al. (U.S. Patent Application Publication No. 2003/0104174) (hereinafter "Itakura"). In addition, claim 24 remains rejected under 35 U.S.C. §103(a) as being unpatentable over Bernstein.

As indicated above, claims 1-6 and 8-23 were amended to correct typographical mistakes.

Further, claims 8-10 and 22 were amended to provide consistency with the cancellation of claim 7.

Further, claims 1 and 23 were amended to advance prosecution. This is not an admission that these amendments, as discussed below, were necessary to overcome the Examiner's 35 U.S.C. §§102 and 103 rejections. Claim 1 was amended to include the limitations of "wherein said first and second identification portions are unique in form, wherein text, characters and/or images of said first identification portion are misaligned relative to those of said second identification portion to create a further image, character and/or text which is different in appearance to said first and second identification portions." Support for this amendment may be found at least in part in paragraph [0015] of Applicant's Specification. Further, claim 23 was amended to include the limitations of "wherein said first and second identification portions are



laid down substantially simultaneously, wherein said first and second identification portions are randomly computer generated." Support for these amendments may be found at least in part in paragraphs [0027 and 0035] of Applicant's Specification.

Hence, no prosecution history estoppel arises from the amendments to claims 1-6 and 8-23. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1-6 and 8-23 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicant thanks Examiner Battula for discussing the case with Applicant's attorney, Bobby Voigt, on January 6, 2009. Examiner Battula agreed to allow pending claims 1-6 and 8-24, with the present claim amendments, provided that the Examiner does not find new relevant art in a subsequent search.

As was discussed with Examiner Battula on January 6, 2009, independent claims 1 and 23 are allowable for at least the reasons stated herein.

None of the references cited by the Examiner, taken singly or in combination, teach "wherein said first and second identification portions are unique in form, wherein text, characters and/or images of said first identification portion are misaligned relative to those of said second identification portion to create a further image, character and/or text which is different in appearance to said first and second identification portions" as recited in claim 1. Neither do any of the references cited by the Examiner, taken singly or in combination, teach "wherein said first and second identification portions are laid down substantially simultaneously, wherein said first and second identification portions are randomly computer generated" as recited in claim 23.

In connection with the claim objections for informalities, Applicant amended claims 1-22 to correct the typographical mistakes as requested by the Examiner.



In connection with the rejections of claims 7-14 and 22 under 35 U.S.C. §§112, first and second paragraphs, Applicant cancelled claim 7 thereby addressing the Examiner's concern that claim 7 includes substantially similar language as claim 1.

In connection with the rejection of claim 24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention due to the use of the phrase "substantially simultaneously," Applicant respectfully asserts that the scope of claim 24 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Applicant respectfully asserts that the terms "substantially" and "simultaneously" are clearly understood. "Simultaneously," as defined by Merriam-Webster, means "existing or occurring at the same time." See <http://www.merriam-webster.com/dictionary/simultaneously>. Further, "substantially," as defined by Merriam-Webster, means "being largely but not wholly that which is satisfied." See <http://www.merriam-webster.com/dictionary/substantially>. Hence, the phrase "substantially simultaneously," as recited in claim 24, may refer to largely but not wholly existing or occurring at the same time. A further discussion of "substantially simultaneously" may be found at least in part in paragraph [0027] of Applicant's Specification. Thus, the scope of claim 24 would be clear to a hypothetical person possessing the ordinary level of skill in the pertinent art. According to M.P.E.P. §2171, a claim particularly points out and distinctly defines the metes and bounds of the subject matter if the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

Furthermore, Applicant identified 9,336 patents on the USPTO website that were issued since 1976 that used the phrase "substantially simultaneously" in the claims. Clearly the use of this phrase in claims is common and the use of this phrase cannot be the sole reason or rationale for rejecting claim 24 under 35 U.S.C. §112, second paragraph. Otherwise, there would be several thousands of patents that are invalid for having indefinite claims.



Further, the Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. §112, second paragraph, should be whether the claim meets the threshold requirement of clarity and precision, not whether more suitable language or modes of expression are available. M.P.E.P. §2173.02. Definiteness of claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure; the teachings of the prior art; and the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. M.P.E.P. §2173.02. In reviewing a claim for compliance with 35 U.S.C. §112, second paragraph, the Examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. §112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000); M.P.E.P. §2173.02. As shown above, the scope of claim 24 and in particular the limitation involving the phrase "substantially simultaneously," when analyzed in light of the Specification, can be determined by one of ordinary skill in the art and therefore serves the notice function required by 35 U.S.C. §112, second paragraph. Consequently, Applicant respectfully asserts that claim 24 is allowable under 35 U.S.C. §112, second paragraph, and respectfully requests the Examiner to withdraw the rejection of claim 24 under 35 U.S.C. §112, second paragraph.



As a result of the foregoing, it is asserted by Applicant that claims 1-6 and 8-24 in the Application are in condition for allowance, and respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicant

By: 

Robert A. Voigt, Jr.  
Reg. No. 47,159

P.O. Box 50784  
Dallas, Texas 75201  
(512) 370-2832